

Application No.: 09/385,299
Attorney Docket No. 93-3-513

REMARKS

By this Amendment, Applicants amend claim 1 to more appropriately define the subject matter claimed therein. Claims 1-17 and 30-46 remain pending. Applicants also request withdrawal of the finality of the Final Office Action based on a failure by the Examiner to substantively address the elements of claims 12 and 41.

In the Final Office Action of September 30, 2003, the Examiner rejected claims 1, 2, 5, 7-10, 12, 13, 15, 16, 30, 31, 34, 36-39, 41, 42, 44, and 45 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,363,434 to *Eytchison*; and rejected claims 6, 11, 14, 17, 35, 40, 43 and 46 under 35 U.S.C. § 103(a) as unpatentable over *Eytchison* in view of Official Notice. In addition, the Examiner objected to claims 3, 4, 32, and 33 as being dependent upon a rejected base claim. Applicants submit that the rejections and objection should be withdrawn for the reasons discussed below.

Objection to claims 3, 4, 32, and 33

The Examiner objected to claims 3, 4, 32, and 33 as being dependent upon a rejected base claim, indicating these claims would be allowable if rewritten in independent form with all base and intervening claim recitations. Because claims 3, 4, 32, and 33 depend, directly or indirectly, from claims 1 and 30 (which are allowable for the reasons presented below), Applicants request withdrawal of the objection and the timely allowance of these pending claims.

Rejection under 35 U.S.C. § 102(e)

Applicants submit that claims 1, 2, 5, 7-10, 12, 13, 15, 16, 30, 31, 34, 36-39, 41, 42, 44, and 45 are not anticipated by *Eytchison*. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found,

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either expressly described or under principles of inherency, in a single prior art reference.

Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Claim 1 recites a combination of elements, including:

attempting, by a portable access device, to establish a communication link between the portable access device and said first network server using one of a plurality of communication media, in accordance with said communication protocol.

Eytchison fails to teach or suggest at least the above claimed steps. According to *Eytchison* (col. 6, line 64 – col. 7, line 9):

In the present embodiment, the user application 310 of FIG. 3 sends the request to the resource manager 320 [located in server 214] in the form of an event list that indicates the source device, the destination device and the requested action. Thereafter, the resource manager 320 determines the availability of the source and destination devices, and checks whether sufficient bandwidth is available for carrying out the requested action. If the devices and the bandwidth are available, the resource manager 320 will return a "granted" signal and transmits the necessary control commands to the software device proxies 370a-370i. The software device proxies 370a-370i then control the devices [210, 211, 212, 222a] via IEEE 1394 bus interface 380.

The Examiner alleges that *Eytchison*'s media devices 210, 211, 212, and 222a "read as portable access devices" and that *Eytchison*'s resource manager in home server 214 "identifies communications protocols and establishes...[a] communications connection" (Office Action "OA," page 2). Contrary to the Examiner's position, *Eytchison* fails to anticipate claim 1.

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Claim 1 recites "attempting, by a portable access device, to establish a communication link between the portable access device and...[a] first network server." In order to meet the terms of claim 1 using the Examiner's logic, *Eytchison's* media devices would need to attempt to establish a communication link with the home server. However, this is not the case with *Eytchison's* system. In *Eytchison's* system, a user application in a home server sends a request to a resource manager, also in the home server. When the resource manager grants the request, the resource manager transmits control commands to software device proxies in the home server, which in turn control the source and destination media devices. Thus, *Eytchison* does not teach at least "attempting, by a portable access device, to establish a communication link with a first network server."

As set forth above, anticipation under 35 U.S.C. § 102(e) requires that each and every claim element be disclosed by the applied reference in as complete detail as is in the claim. *Eytchison* does not teach each and every feature of independent claim 1 and therefore, as a matter of law, cannot anticipate this claim. Thus, the rejection of independent claim 1 under 35 U.S.C. § 102(e) should be withdrawn.

Similar to claim 1, independent claim 7 recites a combination including:

receiving a request from a portable access device to access a network server;

identifying a communication protocol associated with said network server; [and]

transmitting said communication protocol to said portable access device.

Eytchison fails to teach or suggest at least the above-noted claimed elements.

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First, *Eytchison* does not teach “receiving a request from a portable access device to access a network server,” as claimed. Instead, *Eytchison* mentions that a resource manager located in a home server receives a request from a user application, which is also in the home server. As the Examiner acknowledges, “a user issues a request to access server (214)” via a user application in the server (OA, page 3 (emphasis added)). Receiving a request from a user application, as mentioned by *Eytchison*, is not consistent with receiving a request from a portable access device, as claimed. Thus, *Eytchison* fails to teach at least “receiving a request from a portable access device to access a network server,” as claimed.

Further, *Eytchison* fails to teach at least identifying a communication protocol associated with the network server and transmitting said communication protocol to the portable access device, as recited in claim 7. In *Eytchison*’s system, the resource manager checks whether sufficient bandwidth is available and, if the bandwidth is available, transmits control commands to software device proxies in the home server, which in turn control the source and destination media devices. *Eytchison*’s home server does not transmit identified communications protocols associated with the home server to the media devices; instead, it transmits control commands to software device proxies. Transmitting control commands to software proxies, as mentioned in *Eytchison*, is not consistent with transmitting identified communications protocols associated with a server to a portable access device, as claimed.

Further, neither checking whether sufficient bandwidth is available, as mentioned by *Eytchison*, nor “controlling communications lines and bandwidth allocations” (OA, page 3), is consistent with identifying (or transmitting) communications protocols associated with a server,

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as claimed. Moreover, contrary to the Examiner's allegations (OA, page 3), "allocating lines and bandwidth" is not consistent with identifying a communication protocol associated with a network server and transmitting the protocol to a portable access device, as claimed. Indeed, the Examiner fails to point to any portion of *Eytchison* to support the allegation that this reference anticipates identifying a communication protocol associated with the network server and transmitting said communication protocol to a portable access device, as recited in claim 7.

The Examiner alleges: "[a]ny information transmitted to the portable access device which establishes the communications link reads as the transmission of a communications protocol to the portable access device" (OA, page 7). This allegation is conclusory and wholly unsubstantiated by evidence on the record. Moreover, it fails to advance the notion that *Eytchison* anticipates transmitting identified communications protocols to a portable access device, as claimed. Anticipation under 35 U.S.C. § 102(e) requires that each and every claim element be disclosed in as complete detail as is in the claim by the applied reference.

Because *Eytchison* fails to teach each and every feature of independent claim 7, *Eytchison*, as a matter of law, cannot anticipate that claim. Thus, the rejection of independent claim 7 under 35 U.S.C. §102(e) should be withdrawn.

Similar to allowable claim 1, independent claim 30 recites, *inter alia*:

attempting to establish a communication link between a portable access device and said first network server using one of a plurality of communication media in accordance with said communication protocol.

Similar to allowable claim 7, independent claim 36 recites, *inter alia*:

receiving a request from a portable access device to access a network server;

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identifying a communication protocol associated with said network server; [and]

transmitting said communication protocol to said portable access device.

Claims 30 and 36 are allowable for at least the reasons presented above in connection with claims 1 and 7.

Each of independent claims 12 and 41 recites a combination including:

transmitting from a portable access device to a first network server a request to access a second network server;

receiving said request at said first network server;

identifying a communication protocol associated with said second network server;

transmitting said communication protocol from said first network server to said portable access device; and

establishing a communication link between said portable access device and said second network server.

Initially, Applicants point out that the Examiner has not substantively addressed the above features of claims 12 and 41 in the Final Office Action nor in any previous Office Action. In particular, the Examiner did not address the elements recited in claims 12 and 41 of a first and second server. Instead, the Examiner merely reproduces, verbatim, the same reasons as presented for rejecting claim 7.

The Examiner's rejection of claims 12 and 41 is ambiguous and does not provide Applicants a fair opportunity to reply. Applicants cannot discern how, if at all, the Examiner is applying *Eytchison* to the elements of claims 12 and 41. The rejection does not articulate which features the Examiner believes the reference teaches.

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Applicants remind the Examiner that:

[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. M.P.E.P. § 706 (8th ed. 2001).

Applicants also remind the Examiner of the provisions of M.P.E.P. § 706.02(j), which include:

[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply...[and]

the examiner should set forth in the Office action...the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.

Thus, should the Examiner continue to dispute the patentability of Applicants' claims, Applicants request a new non-final Office Action (and a resetting of the period for reply) setting forth the relevant teachings of the prior art relied upon in the rejection of claims 12 and 41.

The Examiner's failure to address claims 12 and 41 notwithstanding, Applicants submit the following remarks in response to the Final Office Action. The Examiner has not shown that claims 12 and 41 are anticipated by *Eytchison*. For example, receiving by a resource manager in a server a request from a user application in that same server is not consistent with receiving at a first network server a request from a portable access device to access a second network server, as claimed. Moreover, neither "controlling communications lines and bandwidth allocations" nor "allocating lines and bandwidth" (OA, page 4) is consistent with transmitting a communication protocol associated with a second network server to a portable access device from a first network

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server, as claimed. For at least these reasons, the Examiner has failed to show that claims 12 and 41 are anticipated by *Eytchison*.

Because *Eytchison* fails to teach each and every feature of independent claims 12 and 41, *Eytchison*, as a matter of law, cannot anticipate these claims. Thus, the rejection of independent claims 12 and 41 under 35 U.S.C. §102(e) should be withdrawn.

Dependent claims 2, 5, 8-10, 13, 15, 16, 31, 34, 37-39, 42, 44, and 45 are allowable for at least the same reasons as presented above in connection with allowable base claims 1, 7, 12, 30, 36, and 41, respectively. Accordingly, Applicants request withdrawal of the rejection of claims 1, 2, 5, 7-10, 12, 13, 15, 16, 30, 31, 34, 36-39, 41, 42, 44, and 45 under 35 U.S.C. §102(e) and the timely allowance of these pending claims.

Rejection of claims 6, 11, 14, 17, 35, 40, 43 and 46 under 35 U.S.C. § 103(a)

Dependent claims 6, 11, 14, 17, 35, 40, 43 and 46 are patentable for at least the same reasons as presented above in connection with allowable base claims 1, 7, 12, 30, 26, and 41, respectively. For at least this reason, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

Moreover, Applicants submit that a *prima facie* case of obviousness has not been established with respect to claims 6, 11, 14, 17, 35, 40, 43 and 46. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention.

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Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

In rejecting claims 6, 11, 14, 17, 35, 40, 43 and 46, the Examiner avers (OA, page 6):

Eytchison only differs from the claims in that the portable devices are hardwired to the server as opposed to being connected in a wireless manner. However, examiner takes Official Notice that it is well-known in the art to establish data communication links using wireless connections. It would have been obvious to one of ordinary skill in the art to modify *Eytchison* to utilize wireless connections on the LAN illustrated in FIG. 2 so as to enhance the convenience of the user by eliminating the need to plug wires into the portable devices.

Initially, Applicants traverse the Examiner's taking of Official Notice. Applicants call the Examiner's attention to the provisions of M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the elements recited in claims 6, 11, 14, 17, 35, 40, 43 and 46 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Accordingly, Applicants traverse the Official Notice and request that the Examiner either cite a

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competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Should the Examiner fail to produce competent documentary evidence to support the taking of Official Notice, Applicants request that the Examiner provide the required "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." M.P.E.P. § 2144.03 (internal citations omitted). Merely mentioning cellular telephones and pagers does not fulfill the requirement for "specific factual findings."

Moreover, Applicants remind the Examiner that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

In this case, there is no "substantial evidence" in the record to support the alleged modification of *Eytchison*, and the requisite "clear and particular" motivation required to support a *prima facie* case of obviousness is lacking. The Examiner points to no evidence supporting the assertion that a skilled artisan having *Eytchison* before him would have been motivated to modify the reference in a manner resulting in Applicants' claimed invention. The Examiner merely provides a general description of how certain features were supposedly well-known and provides only conclusory statements, lacking evidentiary basis, supporting a motive for modifying *Eytchison* in a manner resulting in Applicants' claimed combination. For example,

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the Examiner alleges that a skilled artisan would have modified the reference "so as to enhance the convenience of the user by eliminating the need to plug wires into the portable devices." This statement is not supported by "substantial evidence" on the record, as the Examiner points to evidence in *Eytchison* mentioning such a "enhanced convenience."

Further, *prima facie* obviousness requires a reasonable expectation of success in modifying the reference at the time the invention was made. *See* M.P.E.P. § 2143.02. There is no evidence on the record to support the notion that a reasonable expectation of success would have existed at the time of the invention arising from the modification of *Eytchison* "to utilize wireless connections." *Eytchison* explains that the electronic media devices (e.g., VCR, TV, CD player, DVD player) are connected to the home server via an IEEE 1394-1995 bus, which is used to provide multiple channels for isochronous data transfers (col. 5., line 30 – col. 6, line 5). The Examiner fails to show that there would have been a reasonable expectation of success arising from providing multiple channels for isochronous data transfers wirelessly at the time of the invention. That is to say, there is no evidence on the record to support the notion that, at the time the invention was made, there would have been a reasonable expectation of success from providing wireless transmission of the IEEE 1394 protocol. Indeed, Applicants submit that there would not have been a reasonable expectation of success from providing wireless multiple-channel isochronous data transfer for electronic media devices (e.g., VCR, TV, CD player, DVD player).

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claims 6, 11, 14, 17, 35, 40, 43 and 46. Applicants therefore request

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withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

Conclusion

It is respectfully asserted that the present application is in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner continue to dispute the patentability of the pending claims, a withdrawal of the finality of the rejection and the issuance of a new non-final Office Action in this case is earnestly solicited.

Applicants request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-17 and 30-46 in condition for allowance. The proposed amendments to claim 1 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. This Amendment should therefore allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. Entry of this Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance, or in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The claimed invention is neither anticipated nor rendered obvious in view of the cited prior art. Applicants therefore request entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified above, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, and not requested by attachment, such extension is hereby requested. Please charge those fees to Deposit Account No. 07-2339.

Respectfully submitted,

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Dated: December 29, 2003

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